

S/N 09/160,916



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Y. Smyth  
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	WOOLFORD ET AL.	Examiner:	D. TAYLOR
Serial No.:	09/160,916	Group Art Unit:	3672
Filed:	SEPTEMBER 25, 1998	Docket No.:	3616.20USC3
Title:	COMPOSITE MASONRY BLOCK		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on June 3, 1999.

By

John J. Cresens

INFORMATION DISCLOSURE STATEMENT (37 C.F.R. §1.97(c))

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This statement should be considered because it is submitted after the mailing date of a first Office Action on-the-merits, but before the mailing date of a final action under 37 C.F.R. § 1.113, and before the mailing date of the Notice of Allowance under 37 C.F.R. § 1.311. Enclosed is a check in the amount of \$240.00 under 37 C.F.R. § 1.17(p) for consideration of the items listed on the enclosed Form 1449.

The Applicant wishes to call the Examiner's attention to the following materials, which were cited in opposition proceedings on a related Australian patent application. (The opposition was subsequently withdrawn).

- Pisa II brochure with 1988 copyright notice, shows a retaining wall with geogrid layers between courses of blocks having tongue and groove connectors. It is difficult for applicant to tell if this brochure was made of record in a predecessor application.

A similar brochure, showing the blocks without the grid was cited in the predecessor

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applications. The Pisa II blocks are lacking in many of the features of the claimed invention.

- Statutory Declaration of Al Pfannenstien describes the alleged March 1989 Menards meeting that was discussed in the Forsberg and McDonald deposition excerpts previously made of record.
- Christie and Issacs, Australian Concrete Masonry Design and Construction (March 1976) describes block making procedures and equipment.

In litigation respecting U.S. Patent No. 5,827,015, (the parent to this application), assertions were made that a Keystone brochure entitled "Beautiful Do-It-Yourself Results," and bearing a Library of Congress date stamp of June 27, 1988, was not adequately called to the Examiner's attention. A copy is provided herewith. This brochure was of record in the predecessor applications, Serial No. 413,050 and 413,400, and thus is of record in this case. It was cited by the Examiner in those cases (both applications for design patents) in rejecting the claims presented. The brochure shows a block like that shown in another reference of record, Canadian Design Registration No. 62,875, (also enclosed), but having slightly different proportions.

In the litigation, it was also asserted that the Applicant had not advised the Examiner of the protest filed by the Applicant against application Serial No. 485,736. In that application, Keystone applied for a design patent for essentially the same ornamental appearance claimed by the Applicant in application Serial No. 413,400, which had been rejected by the Examiner. Since the same art was applicable against both applications, Applicant filed a protest to point out that the Examiner should act consistently in both cases. If the Examiner was not going to allow the claim on one application, it should not do so on either application. Conversely, if the Examiner was going to allow the claim on one, it should do so on both, thus

paving the way for an interference. Applicant was not taking a position that the Examiner was correct in her rejection of the Applicant's application, and was not taking a position that is inconsistent with the position it has taken throughout this prosecution, that the claims it has submitted are patentable.<sup>1</sup>

In the litigation, it was also asserted that the Applicant had not adequately advised the Examiner of U.S. Patent No. 4,914,876 and Canadian Patent No. 1,188,116, although both of those references had been made of record, because these references had been combined to support a rejection of a claim in one of the predecessor applications Serial No. 651,322. Each reference lacks the features of the claimed invention, and is cumulative of other references previously brought to the Examiner's attention and extensively discussed.

Finally, it was asserted in the litigation, that the Applicant should have provided the Examiner with literature on a Keystone Mini Cap unit. Such literature is of record in the predecessor applications, in the form of a brochure entitled, "Keystone Retaining Wall Systems," a copy of which is provided herewith. Another Keystone brochure, entitled, "Keystone International Compac Unit Installation Guidelines," which is also of record in the predecessor applications, and a copy of which is also enclosed herewith, also depicts Keystone cap units. The cap units shown in these brochures do not include the locator flange feature of the claimed invention. They rely upon a pinned connection. A Keystone Design Patent No. 299,067 showing cap units was previously made of record. A similar retaining wall unit is also shown in U.S. Patent No. 2,882,689, which was also previously made of record.

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<sup>1</sup> Following the filing of Applicant's protest, Keystone abandoned the claim that was the subject of the protest. Applicant did not continue to prosecute its design claims, but chose to pursue utility claims.

Since some of the claims presented in this application include cores extending through the block body, Applicant wishes to bring the following publications to the Examiner's attention:

"The Johnson Block Retaining Wall System,"

Swiss Patent Publication CH 663437 A5,

Canadian Patent No. 2,012,286,

U.S. Patent No. 4,909,010,

U.S. Patent No. 4,229,123, and

Australian Patent Publication AU 17231/83.

In accordance with 37 C.F.R. §1.98(a)(2), a copy of each document or other information listed on the enclosed Form 1449 is provided to the extent that it is newly cited or discussed above. To the extent that the publications are already of record in the parent patent and not discussed above, the Applicant has provided copies of the Form 1449's from the parent case with the new serial number of this application.

No representation is made that a reference is "prior art" within the meaning of 35 U.S.C. §§ 102 and 103 and Applicants reserve the right, pursuant to 37 C.F.R. § 1.131 or otherwise, to establish that the reference(s) are not "prior art." Moreover, Applicants do not represent that a reference has been thoroughly reviewed or that any relevance of any portion of a reference is intended.

Consideration of the items listed is respectfully requested. Pursuant to the provisions of M.P.E.P. 609, it is requested that the Examiner return a copy of the attached Form 1449, marked as being considered and initialed by the Examiner, to the undersigned with the next official communication.

Please charge any additional fees or credit any overpayment to Deposit Account

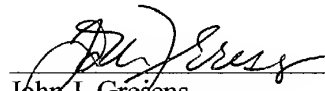
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Respectfully submitted,

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Date:

June 3, 1999

  
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